

REMARKS

Claims 1-25 are pending in the present application. Independent claims 1, 15 and 21 are the focus of this request.

Independent claims 1 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Nakagawa et al.* (US Patent 5,838,911).

Independent claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Kobata* (US Patent 6,058,418) in view of *Shah* (US Patent 6,029,065) and further in view of *Nakagawa et al.* (US Patent 5,838,911). Applicant submits the rejections are improper, and respectfully requests the review board reverse the findings contained in the Final Office Action.

Applicants maintain the arguments presented in the Response dated November 23, 2005, and incorporate them by reference herein. More specifically, the cited art, alone or in combination, fails to teach or suggest “a central server of an access or service provider, the central server having an interrogation part for interrogating hardware and software configurations of a plurality of terminal devices “ as recited in claim 1, and similarly recited in claim 21. Under the recited features, a central server is responsible for interrogating terminal devices to determine hardware and software configurations and to subsequently load software and/or data as a result of the interrogation. Claims 1 and 21 further recite that the terminal devices include a response transmitting part for transmitting a configuration code identifying the respective hardware and software configuration to the central server in response to an inquiry by the interrogation part. Thus, the claims clearly show that the server first sends out an interrogation inquiry, and the terminal devices then transmit a configuration code.

In contrast, *Kobata* describes an Internet based client/server application, where the server application records client’s demographic information including CPU power, log-in history, etc. to forward to the Internet service provider (col. 2, line 66 - col. 3, line 4). In the system of *Kobata*, clients transfer data relating to client infrastructure to a remote server by means of client software that is downloaded from content providers and executed within the terminal (FIG. 4,

col. 4, lines 57-67). The corresponding data transfer is thus initiated on the client side, and not from the server side (col 3, lines 6-9 and col. 3, lines 52-60).

Furthermore, claims 1 and 21 recite that a "configuration code" is transmitted for identifying the respective hardware and software configuration (see amended specification, page 7, lines 11-22). Kobata is silent regarding this feature - instead, the reference merely discloses the transmission of various different infrastructure data, which may include the serial number of specific software being used on the client's device (col. 3, lines 1-9; 52-60). There is no teaching or suggestion within Kobata that discloses the use of a configuration code that identifies the software and hardware configuration of the terminal. The terminal devices of the present claims also comprise a response transmitting part for transmitting a configuration code representing the hardware and software configuration to the server in response to a query sent by the interrogating part and a software receiving part for receiving and internally storing transmitted software and data. Such a configuration is not disclosed in *Kobata*.

Also, Claims 1, 15 and 21 recite an interactive control/menu for the interactive specifying of a charging mode for at least one of downloaded software and downloaded data in the context of offer information. The Office Action has conceded that this feature is not taught in Kobata.

Regarding *Nakagawa*, the reference relates to a system and a method for distributing and maintaining software, as opposed to demographic marketing data, disclosed in *Kobata*. *Nakagawa* provides for a client/server system in which a client program in a user's computer directs a query to a software provider's server over a network. Information about the current software version is requested in the query (Abstract, col. 1, lines 13-19 and col. 8, lines 26-36). *Nakagawa*, teaches that the seller specifies an "access qualification level" of the respective customer on the server side (column 67, lines 50-60). The customer is then offered various functionalities on the basis of the customer's access qualification level. When the seller specifies the access qualification level on the server, the seller specifies whether or not the customer or user has to pay in advance (i.e. which payment method is available to the customer - column 67, lines 39-48). Thus, the access qualification levels in *Nakagawa* are a matter of rights for the respective user that are defined only by the seller on the server, as opposed to the server and the terminal devices. The system described by *Nakagawa* contains no distributed control means that

are arranged in both the server and the client. Interactive control of the software transmission is controlled on the server side exclusively.

Furthermore, *Nakagawa* teaches that the payment method available to each user is specified in a customer database on the server side (column 67, lines 62-67 and column 68, lines 17-29). Only those purchase orders which contain the payment method specified for the respective user are acknowledged. In contrast, the present claims recited that the distributed control means enable the interactive determination of a charging mode for downloading software and/or data. Such an interactive determination of a charging mode does not take place in the system and method disclosed in *Nakagawa*, which explicitly discloses that the payment method for an individual user is unilaterally and permanently specified by the seller in the seller's database (i.e., there is no interaction with the client in this regard). For the foregoing reasons, the rejection under 35 U.S.C. §103 are improper and should be withdrawn..

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Kobata/Nakagawa* and *Kobata/Shah* references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).


Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Regarding *Kobata/Nakagawa*, it was pointed out that in *Kobata*, a transfer of information to the server takes place which is initiated on the client side. In contrast, *Nakagawa* teaches that the transfer is initiated exclusively from the server side. Furthermore, the system in *Kobata* is premised upon a transparent system that is designed to minimize user interaction with the server by allowing the content providers to decide which content will be transmitted (col. 2, lines 16-24, 46-55; col. 4, lines 43-45). As such, there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine these references as suggested in the Office Action. Furthermore, regarding the *Shah* reference, the disclosure does not even contemplate the use of a central server. As such, Applicants submit the rejections are improper and should be reversed.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is improper, and Claims 9-16 of the present application are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that the Board overturn the rejection and issue a timely Notice of Allowance in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-1034) on the account statement.

Respectfully submitted,
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